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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,909	10/24/2003	Naoki Tajima	990587C3/LH	8719
1933	7590	04/13/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			PHAM, HAI CHI	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			2861	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/692,909	Applicant(s) TAJIMA ET AL.	
	Examiner Hai C Pham	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-108 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/406,244.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/406,244, filed on 09/24/99.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-13, 17-32, 35-49 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 5-10, 13, 19, 4, 20, 14, 21-23, 25-30, 33-34, 24, 35-37, 38-40, 42-47, 50-51, 41, 52-54 of prior U.S. Patent No. 6,677,973. This is a double patenting rejection.

It is noted that the corresponding claims recite the same limitations, despite a slight difference in wording, e.g.:

Claim 1 of the current application:

- **a lens positioning device to position** at least one lens of the plurality of lenses **rotatably** around an axis parallel to the length of the at least one lens to adjust a characteristic of a scan line image **in an adjustment process**" (next to the last paragraph)

Claim 1 of U.S. Patent No. 6,677,973:

- **a lens attitude adjusting device including a tilting device to rotate** at least one lens of the plurality of lenses around an axis parallel to the length of the one lens to adjust the characteristic of a scan line image" (next to the last paragraph)

Both the "lens positioning device" and the "lens attitude adjusting device or tilting device" perform the exact same function, which consists of "rotating" at least one lens of the plurality of lenses around an axis parallel to the length of the at least one lens.

Furthermore, the terminology "lens attitude adjusting device" is a claimed terminology, which is only found in the claim itself. The specification only uses the terminology "tilt" and equates it to the term "rotation". Therefore, the above corresponding claims are claiming the exact limitations.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 52-108 are rejected under the judicially created doctrine of double patenting over claims 1-54 of U. S. Patent No. 6,677,973 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: although "a tilting device to rotate at least one lens of the plurality of lenses around an axis parallel to the length of the one lens" is not explicitly recited, the current application recites that "at least one lens of the plurality of lenses is rotatable around an axis parallel to the length of the at least one rotatable lens" implicating such tilting or rotating device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-4, 9-13, 16-21, 26-30, 33-38, 43-47, 50-57, 62-66, 69-76, 81-85, 88-95, 100-104, and 107-108 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U.S. 6,452,687).

Suzuki et al. discloses a color image forming apparatus (Figs. 1-3) comprising a first image forming device (51) including a first scanning optical device (3C) to form a first image and a first developing device (4C) to develop the first image into a first color toner image, and a second image forming device (52) including a second scanning optical device (3M) to form a second image and a second developing device (4M) to develop the second image into a second color toner image, wherein each of the first and second optical devices comprises a light source (31) which emits a light beam, a deflector (5) which deflects the light beam so as to scan an image forming surface in a main scanning direction with the light beam, a plurality of lenses (61, 10c) provided between the deflector and the image forming surface (1c) to focus the deflected light on the image forming surface, wherein each of the plurality of lenses has a length along the

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main scanning direction (Fig. 1), and a lens positioning device to position at least one lens of the plurality of lenses rotatably around an axis parallel to the length of the one lens to adjust the characteristic of a scan line image (Figs. 8A and 9), and wherein a characteristic of a first scan line image and a characteristic of a second scan line image substantially become the same, when at least one of the lenses (10c) is rotated around the axis parallel to the length of the lens.

Suzuki et al. further teaches :

- the deflector includes a polygon mirror (5),
- third and fourth image forming devices (53, 54) including respective scanning optical devices (3Y, 3BK) and respective developing devices (4Y, 4BK), wherein each of the third and fourth scanning optical devices also comprises a light source, a deflector, a plurality of lenses, and a lens positioning device,
- one of the plurality of lenses comprises a f- θ lens (61),
- the at least one rotatable lens (10c) is positioned closest to the image forming surface among the plurality of lenses (Fig. 8A),
- the characteristic of the first scan line image and the characteristic of the second line image is a straight line (correcting the bow scan line) (Fig. 8A),
- an adjustment device to adjust at least one of the first, second, third and fourth scanning optical devices so that the scanned images formed by of the first, second, third and fourth scanning optical devices are superposed on a recording sheet (the positional deviation in the process direction as well as the positional deviation in the lateral direction are adjusted by adjusting the write start timing of

each color image so as to eliminate deviation among the colors) (col. 12, lines 30-41),

- the image forming surface comprises a surface of a common image bearing member (1c),
- the positioning device of each of the first and second optical device allows the respective at least one rotatable lenses to be rotatable so as to make the respective line images to become a desired line (correcting the curve of the scan line so as to make the scan line a straight line) (Fig. 8A),
- each of the first and second images comprises a line image and the characteristic of the image comprises a shape of the line image (bow or curved scan line).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM
PRIMARY EXAMINER

April 6, 2004